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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/008,295
Filing Date: November 13, 2001
Appellant(s): ROBERTS ET AL.

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GROUP 3600

Michael G. Savage
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 11, 2006 appealing from the Office action mailed September 23, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: the dependent claims 4, 5, 10 and 11

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are rejected under 35 U.S.C. § 103(a) as unpatentable over a combination of Ahluwalia, Fisher, and "Presence: the Best Thing That Ever Happened to Voice".

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,728,685	Ahluwalia	4-2004
2003/0149640	Fisher et al.	8-2003

Rosenberg, Jonathan "Presence: The Best Thing That Ever Happened To Voice" Communications Convergence.COM, November 5, 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6, 7, 9, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahluwalia (6,728,685) in view of Fisher et al.

Ahluwalia shows providing the shopper a purchase order having an opportunity to select a notification option (see 448), wherein the notification option indicates that the shopper desire to be contacted if a triggering event occurs; receiving from the shopper the purchasing information and optionally supplied notification information; a consumer profile associated with the buyer and associated with the order information and notification information; providing a delivery date; accessing the notification information in the shopper profile; if the shopper selected the notification option, notifying the shopper via email of a changed delivery date. Ahluwalia does not explicitly show that the notification is to be in the case of a triggering event; recognizing the occurrence of the triggering event; and notifying the shopper that the triggering event has occurred. Fisher et al show that the notification is to be in the case of a triggering event; recognizing the occurrence of the triggering event; and notifying the shopper that the triggering event has occurred. It would have been obvious to one of ordinary skill in the art to modify the method of Ahluwalia as taught by Fisher et al in order to provide information to the buyer when the status of the order has been updated.

Claims 4, 5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahluwalia in view of Fisher et al as relied upon in claims 1 and 7 and further in view of Presence: the Best Thing That Ever Happened to Voice (hereafter Presence).

As to claims 4 and 10, Ahluwalia in view of Fisher et al show all elements of the claim except notification information comprising presence information. Presence shows

notification information comprising presence information. It would have been obvious to one of ordinary skill in the art to further modify the method of Ahluwalia by using presence information in order to determine how the person would prefer to be contacted, therefor creating greater customer satisfaction.

As to claims 5 and 11, it is noted that Ahluwalia in view of Fisher et al and Presence shows notification information representative of a plurality of pathways with each having a preferred rank (see second paragraph of page 1 of Presence).

(10) Response to Argument

Preliminary Note: The Examiner has adopted Appellant's outline format for use in addressing Appellants' arguments.

- A. The Combination of Ahluwalia and Fisher Neither Discloses nor Would Have Suggested the Invention Defined by Independent Claims 1, 7, and 12 and Their Dependent Claims 3, 6, 9, and 15

Appellant argues that "Ahluwalia and Fisher fail to describe anything like the notification features as claimed, any combination of Ahluwalia and Fisher would also have lacked those claimed features".

The Examiner does not agree. Ahluwalia discloses the notification feature as claimed. Ahluwalia discloses a method and system wherein a consumer (shopper) is provided real-time information, prior to the placement of an order or purchase by the consumer, regarding the availability and status of a product in relation to the product's manufacturing and delivery process (col. 2, lines 63-67). The consumer has decided to hold a product and has provided the credit information, then a summary of the selected

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product and the transaction is displayed to the consumer (col. 10, lines 18-20). A product delivery schedule projection is displayed (col. 10, lines 22-23). The consumer may further select a means of reporting the product delivery status and a frequency for the report. For example, the consumer may elect to receive status update reports via email, facsimile, or a web page. The status update reports may further provide an updated delivery date, if it is changed from the original date due to changes in the manufacturing or transportation schedule. (Col. 10, lines 28-36)

The Examiner then turns to Fisher for teaching the triggering event. Fisher teaches a system and method for providing order status information. A network address is received from a customer when the customer places an order with a merchant. An information system is interrogated via a network to determine a status of the order. A message indicating the status of the order is automatically composed and transmitted to the network address for the customer. (Paragraph 11) Information about the customers and their respective orders is maintained in a status database. Status information in the status database may be updated manually by order entry personnel or electronically by other means such as status receiver. (Paragraph 19) When status receiver updates the status in status database, it sets a flag to indicate a change of status (paragraph 20). Electronic mail messenger checks the status database to see if the status of any record has changed. If a record has been flagged, then electronic mail messenger composes an electronic mail message based on the new status information and transmits the message to the customer via network. (Paragraph 22) Presence was cited for teaching the receiving of presence information.

Such consumer selecting a means of reporting the product delivery status and a frequency for the report; consumer electing to receive status update reports; and status update reports provide an updated delivery date, if it is changed from the original date due to changes in the manufacturing or transportation schedule are considered the notification feature as claimed.

Such status receiver updating the status in the status database, by setting a flag to indicate a change of status; the flagging then causes an electronic mail message to be composed by an electronic mail messenger that is based on the new status information; and the transmitting of the message to the customer via network are considered the triggering event.

Appellant argues that "the second requirement of a *prima facie* case is missing here. One of ordinary skill in the art would have no motivation to combine Ahluwalia and Fisher at least because these documents teach away from such a combination.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation "to provide information to the buyer when the status of the order has been updated".

A motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the “improvement” is technology independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal and even common-sensical – there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references. *Dystar Fed Cir*, 06-1088 2006

Appellant remarks that “the third requirement of a *prima facie* case is also missing. The Action's suggestion that Ahluwalia and Fisher can be combined ignores the great technical differences between them that would have made the success of such a combination improbably to say the least. Moreover as discussed above, the feature of Ahluwalia and Fisher cannot be combined without further modification to reach the subject matter defined by the claims. In the absence of any suggestion in the cited documents of how to make such a combination operable, one would have faced a serious engineering problem that naturally would have had a low probability of success without substantial experimentation and effort, especially in view of the need to modify the teachings of the documents”.

These are merely conclusions not based on evidence of fact. Furthermore, the analogous art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonable pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. "It is necessary to consider the reality of the circumstances – other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor". *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979)

B. The Combination of Ahluwalia, Fisher and Presence Neither Discloses nor Would Have Suggested the Invention Defined by Dependent Claims 4, 5, 10, and 11

Appellant remarks that "nevertheless, Presence also fails to teach or suggest the features missing from Ahluwalia and Fisher. In particular, Presence fails to disclose an electronic purchase order having an opportunity to select a notification option and electronic purchasing information, wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that affects the performance of delivery occurs".

The Examiner does not agree. Ahluwalia discloses an electronic purchase order having an opportunity to select a notification option and electronic purchasing information, wherein the notification option, if selected, indicates that the shopper

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desires to be contacted that affects the performance of delivery occurs. Ahluwalia discloses a method and system wherein a consumer (shopper) is provided real-time information, prior to the placement of an order or purchase by the consumer, regarding the availability and status of a product in relation to the product's manufacturing and delivery process (col. 2, lines 63-67). The consumer has decided to hold a product and has provided the credit information, then a summary of the selected product and the transaction is displayed to the consumer (col. 10, lines 18-20). A product delivery schedule projection is displayed (col. 10, lines 22-23). The consumer may further select a means of reporting the product delivery status and a frequency for the report. For example, the consumer may elect to receive status update reports via email, facsimile, or a web page. The status update reports may further provide an updated delivery date, if it is changed from the original date due to changes in the manufacturing or transportation schedule. (Col. 10, lines 28-36)

The Examiner then turns to Fisher for teaching the triggering event. Fisher teaches a system and method for providing order status information. A network address is received from a customer when the customer places an order with a merchant. An information system is interrogated via a network to determine a status of the order. A message indicating the status of the order is automatically composed and transmitted to the network address for the customer. (Paragraph 11) Information about the customers and their respective orders is maintained in a status database. Status information in the status database may be updated manually by order entry personnel or electronically by other means such as status receiver. (Paragraph 19) When status

receiver updates the status in status database, it sets a flag to indicate a change of status (paragraph 20). Electronic mail messenger checks the status database to see if the status of any record has changed. If a record has been flagged, then electronic mail messenger composes an electronic mail message based on the new status information and transmits the message to the customer via network. (Paragraph 22)

Presence was cited for teaching the receiving of presence information.

Such consumer selecting a means of reporting the product delivery status and a frequency for the report; consumer electing to receive status update reports; and status update reports provide an updated delivery date, if it is changed from the original date due to changes in the manufacturing or transportation schedule are considered an electronic purchase order having an opportunity to select a notification option and electronic purchasing information, wherein the notification option, if selected, indicates that the shopper desires to be contacted that affects the performance of delivery occurs.

Such status receiver updating the status in the status database, by setting a flag to indicate a change of status; the flagging then causes an electronic mail message to be composed by an electronic mail messenger that is based on the new status information; and the transmitting of the message to the customer via network are considered the triggering event.

Appellant remarks that "the obviousness rejections of Claims 4, 5, 10, and 11 are improper and should be reversed for lack of a *prima facie* case on same grounds as the obviousness rejections of Claims 1 and 7".

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Examiner directs Appellant's attention to the arguments set forth above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MTOT *ms*
May 23, 2007

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